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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/957,451	09/21/2001	Marc O. Schurr	06530.0276-00000	2507
22852	7590	04/21/2005	EXAMINER	
		FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413	PANTUCK, BRADFORD C	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/957,451	SCHURR ET AL.
	Examiner	Art Unit
	Bradford C Pantuck	3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 February 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 4-7, 12, 120-157 and 164-167 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 4-7, 12, 120-157 and 164-167 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02-09-2005</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 120, 123-127, 130, 135-140, 143, 146, 148, 153, and 156 are rejected under 35 U.S.C. 102(b) as being anticipated by Jewusiak US 4,424,810.
2. Regarding claims 120, 135, 136, 146, 148, and 156, Jewusiak discloses a two-armed clip that has a projection in the gap between the arms. The clip is absorbable. The projection is element 15. Element 15 can be alternatively interpreted as the anchoring portion.
3. Regarding claims 123, 125, 126, 127, 137-140, the anchoring portion has two projections 15 & 25 and the projections are located opposite each other.
4. Regarding claim: 124 and 138, the projection includes a portion in the shape of a barb. Element 15 is in the shape of a barb.
5. Regarding Claims 130, 143, and 153, portions 21 and 22 are each tapered portions, curving away from the gap between the two arms.
6. Claims 1, 2, 4-7, 120, 121, 123-125, 128, 129, 131-135, 137-139, 141, 142, 144-150, 154-157, and 164-167 are rejected under 35 U.S.C. 102(b) as being anticipated by Cerwin et al. (Cerwin) US 4,449,531. Cerwin discloses a clip with an anchoring portion and a fixation hole. The anchoring portion has a pin [Fig. 7].

7. Regarding Claims 5, 132, and 144, member 64/65 is a gripping tab capable of engaging member 66.
8. Regarding Claim 124, member 66 is shaped like a barb.
9. Claims 1, 2, 4-7, 120, 121-129, 131-142, 144-152, 154-157, and 164-167 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,620,452 to Yoon. Yoon's clip is bioabsorbable and is shown clamping tissue in the manner claimed in Fig. 14.
10. Regarding Claim 122, portion 23 is capable of anchoring.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,620,452 to Yoon

U.S. Patent No. 5,667,518 to Pannell

U.S. Patent No. 4,967,949 to Sandhaus

U.S. Patent No. 4,394,864 to Sandhaus

U.S. Patent No. 5,171,253 to Klieman

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Response to Arguments

13. Applicant's arguments, see "REMARKS", filed February 9, 2005, with respect to the rejections with prior art references U.S. Patent No. 4,188,953 to Klieman et al., U.S. Patent No. 4,346,869 to MacNeill, and U.S. Patent No. 5,766,189 to Matsuno have been fully considered and are persuasive. The rejections using these patents have been withdrawn.
14. Applicant's arguments filed February 9, 2005 with respect to U.S. Patent No. 4,424,810 to Jewusiak have been fully considered but they are not persuasive. Although not shown, if Jewusiak's clip were closed onto an area of the body such as the fundus, tissue would be permitted to extend beyond the distal tips of arms 61 and 62. The member 66 would pierce and hold the tissue, thereby securing the clip to tissue (this could be thought of as securing the tissue to the clip).

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15. Applicant's arguments filed February 9, 2005 with respect to U.S. Patent No. 4,449,531 to Cerwin et al. have been fully considered but they are not persuasive. In a similar manner to Jewusiak's clip, Cerwin's clip could be attached to tissue.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradford C Pantuck whose telephone number is (571) 272-4701. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BCP

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April 18, 2005



GLENN K. DAWSON
PRIMARY EXAMINER